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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/003,656 | 11/24/2001 | Peter Klug | 2000DE443 | 5306 |
| 25255 | 7590 | 07/01/2004 | EXAMINER | |
| CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205 | | | WELLS, LAUREN Q | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/003,656 | KLUG ET AL. | |
| | Examiner | Art Unit | |
| | Lauren Q Wells | 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 10 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 10 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 3, 10, 20-24 are pending. The Amendment filed 5/7/04, amended claims 3 and 10.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 5/7/04 to the rejection of claims 3, 10, 20-24 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Amendment to the claims filed 5/7/04, wherein claim 10 is amended, is sufficient to overcome the 35 USC 112 rejection over this claim in the previous Office Action.

103 Rejection Maintained

The rejection of claims 3, 10, 20-24 under 35 U.S.C. 103(a) as being unpatentable over Eierdanz et al. (5,650,158) in view of Carey et al. (XP-002950021) and in view of the Handbook of Cosmetic Science and Technology is MAINTAINED for the reasons set forth in the Office Action mailed 3/24/04, and those found below.

Applicant argues, "the '158 reference also does not disclose the particular hydrophilic part of the compounds recited in claim 10. . .and is limited to a maximum of 22 carbon atoms. . .According to claim 10, the hydrophilic part comprises an ester group. The ester group results from the reaction of the alkenylsuccinic anhydride of formula (I) with a mono- and/or polyfunctional alcohol". This argument is not persuasive. First, it is respectfully pointed out that the instant independent claim places no limitation on the number of carbon atoms, thus such an argument is not commensurate in scope. Second, it is respectfully pointed out that Eierdanz et al. teach succinic anhydride reacted with an alcohol and alkoxy to form a monoester.

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Applicant argues, "The alkyleneoxy and the hydrocarbon groups originate from the alcohol used to prepare the ester. The compounds according to claim 10 of the instant application are illustrated herein below for the case wherein the alkyleneoxy is ethyleneoxy – CH₂CH₂O-. . .A further example. . .can be found in Applicant's preparation example 4. . .Thus, the compounds of the instant invention are different from the compounds of the '158 reference". This argument is not persuasive, as it is in NO way commensurate in scope with the instant claims. It is respectfully pointed out that instant independent claim is merely directed toward an ester of alkenylsuccinic anhydride of formula I, wherein the compound is formed by reacting ethoxylated monoalcohol, propoxylated monoalcohol, fatty alcohol ethoxylate, methyl glycol, methyltriglycol, with formula (I), which is taught by Eierdanz et al. It is respectfully pointed out that Applicant is arguing limitations that are not in the instant claim. Furthermore, as pointed out in the previous Office Action, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Applicant argues, regarding Eierdanz et al., "he also would have to change the hydrophilic part of the compounds of the '158 reference to a polyisobutenyl which is not taught or suggested by the '158 reference, which the examiner suggests can be combined from the Carey et al. reference. However, this is not a 'trivial' task, because one skilled in the art would have to change the synthesis route of the '158 reference as shown hereinabove to be able to

obtain the hydrophilic part of the compounds of claim 10 of the instant application". This argument is not persuasive. First, it is respectfully pointed out that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. Second, as pointed out in the previous Office Action, Carey et al. specifically teach the benefits of utilizing such emulsifiers.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER